

REMARKS

The Office Action of February 28, 2007 has been carefully considered. Reconsideration of this application, and entry of the clarifying amendments proposed, is respectfully requested. The amendments proposed for claims 1 and 12 were not earlier presented as they are in response to the new rejection under 35 USC §112, second paragraph, and merely seek to clarify the previously amended claim in a manner suggested by the Examiner. Entry of the proposed amendment is requested as it is believed to overcome the rejections set forth or to at least reduce the issues to be considered on appeal.

Turning now to the office action, claims 1 and 12 were newly rejected under 35 USC §112, second paragraph. Claims 1-8 and 10 were rejected under 35 USC §103(a) as being unpatentable over Rombauer et al. in the Joy of Cooking book (hereinafter "Rombauer"). Claims 12-18 and 20-23 were rejected under 35 USC 103(a) as being unpatentable over Rombauer (p. 564) in view of US 6,312,754 to Wong (hereinafter "Wong"). Claims 9, 11, 19 and 24 were rejected as being unpatentable over "the above reference as applied to the above claims," and further in view of US 4,143,176 to Krisinski et al. (hereinafter "Krisinski").

Rejection of claims 9, 11, 19 and 24 Incomplete - Final Office Action Premature

In setting forth the rejection of claims 9, 11, 19 and 24, the Examiner indicates that the claims were rejected as being unpatentable over "the above reference as applied to the above claims," and further in view of Krisinski. Applicants respectfully submit that such a rejection is defective on its face. More specifically, Applicants are left only to "guess" which reference is to be applied with Krisinski, because claims 9 and 11 depend from claim 1 (rejected based upon Rombauer), whereas claim 24 is dependent from claim 12 (rejected based upon Rombauer and Wong), and claim 19 is dependent from claim 18 (rejected based upon a combination of Rombauer and Wong). Thus it is not clear whether claims 9, 11, 19 and 24 are rejected based upon a combination of Krisinski with: (i) Rombauer, (ii) Wong or (iii) Rombauer and Wong.

As set forth in 37 CFR §1.104, "The examiner's action will be complete as to all matters..." Moreover, MPEP 707.07(d) indicates that the ground of rejection should be fully and clearly stated, and that claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group. As the

present rejection of claims 9, 11, 19 and 24 is inapplicable to all the claims in the group, the grouped claims depending from different claims that were independently rejected, it is not apparent which combination of references the Examiner has applied. In view of the incomplete nature of the rejection of claims 9, 11, 19 and 24, Applicants respectfully request that the Examiner set forth the combination(s) relied upon for the rejection of claims 9, 11, 19 and 24. Furthermore, in light of the incomplete nature of the Final Office Action, Applicants also request that the finality of the present action be withdrawn and that they be granted an opportunity to further respond to the rejection in the event that the claims stand rejected.

Traversal of Rejections

Claims 1 and 12 were newly rejected under 35 USC §112, second paragraph, and the Examiner indicated the phrase "resistant to subsequent separation of oil" as being indefinite. The Examiner further stated that "it is not known whether oil can separate or not in the composition, or any measurement as to the degree of oil separation that would be acceptable" (Final Office Action; p. 2). In response, Applicants note that it was the separation of oil from the peanut butter that was intended to be characterized by the limitation "the peanut butter resists subsequent separation of oil therefrom" when read in the context of the claim. In order to further clarify the limitation as to separation of oil from the peanut butter, Applicants now propose that claims 1 and 12 read as set forth in claim 1, for example, "wherein ... the peanut butter resists subsequent separation of oil therefrom, having no free oil observed on the surface of the peanut butter after storage for at least 60 days." Applicants further note that support for the clarifying amendment is found in the specification at page 10 thereof. Accordingly, Applicants respectfully request entry of the proposed amendment to claims 1 and 12, and an indication of the withdrawal of the rejection under 35 USC §112, second paragraph.

Turning next to the rejection of claims 1-8 and 10 under 35 USC §103(a) as being unpatentable over Rombauer, Applicants acknowledge that Rombauer teaches ingredients of peanut butter that include peanuts and safflower or vegetable oil. However, Applicants respectfully submit that such teachings do not give rise to a teaching of the limitations of claim 1, let alone dependent claims 2-8 and 10. It appears that the Examiner has ignored or otherwise failed to consider the limitations of claim 1 that require the specific constituent elements be organic in order to produce an organic

peanut butter as recited in the claim. Moreover, claim 1 further requires a total fat concentration of the peanut butter less than about 55wt%. Rombauer does not appear to provide any teaching of this limitation. Nor does Rombauer suggest that the organic oil be non-hydrogenated as required by claim 1. Furthermore, claim 1 requires that the organic peanut butter resist the separation of oil therefrom, and by amendment further indicates that such a property may be determined by no free oil observed on the peanut butter's surface after storage for at least 60 days. In light of the fact that Rombauer fails to teach or suggest several of the limitations set forth in claim 1, Applicants respectfully submit that *prima facie* obviousness has not been established. Applicants respectfully traverse the rejection of claim 1.

With respect to the dependent claims, for purposes of brevity, and in view of the arguments in traversal of independent claim 1, Applicants respectfully submit that claims dependent from claim 1, including claims 2-8 and 10, are also in condition for allowance. Applicants reserve the right to further address specific dependent claims in the future. Applicants do wish to note, however, that the Examiner rejection of claim 2 (Final Office Action; bottom p. 4) contains an incomplete sentence, but seems to suggest that the Examiner is relying on the instant Specification, as a basis for the rejection. Applicants submit that to do so is improper and respectfully traverse the rejection of dependent claims 2-8 and 10.

Furthermore, the remarks directed to Applicants' dependent claims continue to suggest that no unexpected results are achieved by aspects of the rejected claims. Such a statement simply ignores the results set forth by Applicants in the various examples and experiments conducted (see Specification pp. 7-11). As noted by Applicants (e.g., Specification, p. 2, line 20 – p. 2, line 2), they were able to achieve an organic peanut butter formulation that resists oil separation. More importantly, no references have been identified that teach the same problem, let alone Applicants' solution – particularly with respect to the production of an organic peanut butter. Applicants previously requested that in the event the Examiner relied upon allegations of "nothing new" for subsequent rejections, that the Examiner set forth the basis for any such assertion, and more particularly establish where a reference taught or suggested the recited limitations. Or, if the Examiner is taking "Official Notice" of allegedly well-known information, that the Examiner make such information of record for Applicants review. The Examiner has

failed to provide the basis for such statements and Applicants, once again, urge that the rejections relying upon such statements are incomplete.

Claims 12-18 and 20-23 were rejected under 35 USC 103(a) as being unpatentable over Rombauer in view of Wong. Applicants respectfully traverse the rejection as being incomplete and failing to establish a teaching or suggestion of the limitations set forth in claim 12 and claims depending therefrom. Applicant further incorporate the arguments in traversal of the rejection of claim 1 as they may apply to the specific ingredients employed in the recited method of manufacturing organic peanut butter found in claim 12.

In addition, the present rejection suggests that the temperature limitations of claim 12 ("heated mixture with a temperature sufficient to maintain the oil in a liquid state") are somehow taught by Rombauer's suggestion to "make your own full-bodied peanut butter in an electric blender." Not only does Rombauer fail to teach the recited limitation, but it teaches away from heating where it suggests that heating may result in the product growing rancid (p. 564, col. 2, lines 5-7). Taken in context, Rombauer would seem to teach using an electric blender to avoid heating. Moreover, no mention is made of the temperature of the heated mixture, or of cooling a heated mixture to produce a dispensable mixture as required by claim 12. The rejection states that "[c]ooling is a given..." yet provides no basis for such a teaching having been set forth in Rombauer.

Rombauer's suggestion of avoiding heating the mixture also appears to teach away from the process disclosed by Wong, which teaches heating the peanut mixture (e.g., col. 19, lines 49-51). In view of the noted distinctions and contrary teachings, Applicants respectfully urge that Rombauer and Wong teach away from one another, and it would not have been obvious to one of skill in the art to combine the teachings thereof.

Applicants further note that the rejection of claim 12 clearly indicates that the claim "differ[s] from the reference [Rombauer] in the steps of grinding peanuts in a mill and then combining oil and in the use of organically grown peanuts and organic palm oil and in the particular amounts of peanuts." Applicants further urge that the total fat concentration is also not disclosed by Rombauer. The rejection then indicates that Wong teaches various elements, and urges that the recited limitations of claim 12 are taught by Wong. For those particular elements not specifically recited (e.g., the use of organic constituents as recited in claim 12) the rejection simply concludes that such

limitations are of no significance absent a showing of unexpected results. Applicants respectfully submit that Wong itself teaches away from the present invention as it suggests that a preferred embodiment employs hydrogenated stabilizers to produce a characteristic that Applicants have achieved in an organic peanut butter - without the use of the hydrogenated and non-organic stabilizers taught by Wong. Applicants respectfully submit that, at best, the arguable combination of Rombauer and Wong fails to teach the limitations of rejected claim 12 as previously set forth, and as proposed for amendment above. Accordingly the rejection of claim 12 is traversed and the Examiner is respectfully requested to withdraw the rejection.

With respect to those claims dependent from claim 12, particularly including rejected claims 13-18 and 20-23, Applicants submit that such claims are in condition for allowance for the reasons set forth relative to claim 12 and for the sake of brevity do not set forth specific arguments in traversal of the dependent claim rejections. Applicants reserve the right to prevent further arguments relative to the dependent claims in a subsequent response or on appeal.

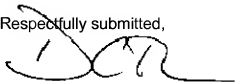
Claims 9, 11, 19 and 24 were rejected as being unpatentable over "the above reference as applied to the above claims," and further in view of Krisinski. As previously noted by Applicants the rejection fails to state with any specificity which combination of patents and/or publications are relied upon for the rejection. As such Applicants are unable to specifically address particular combinations. Applicants do, however, submit that claims 9, 11, 19 and 24 are all dependent from either claims 1 or 12, and are also patentably distinguishable over any combination relying on Rombauer and/or Wong for the reasons set forth above relative to independent claims 1 and 12.

In the event that that rejection of claims 9, 11, 19 and 24 is maintained, Applicants refer the Examiner to prior arguments (Response submitted January 2007), noting that the limitations of claims 9 and 19 are not taught and that Krisinski teaches away from the limitations recited in rejected claims 9, 11, 19 and 24.

In view of the foregoing remarks and amendments, reconsideration of this application and allowance thereof are earnestly solicited. In the event that additional fees are required as a result of this response, including fees for extensions of time, such fees should be charged to USPTO Deposit Account No. 50-2737 for Basch & Nickerson LLP.

In the event the Examiner considers personal contact advantageous to the timely disposition of this case, the Examiner is hereby authorized to call Applicant's attorney, Duane C. Basch, at Telephone Number (585) 899-3970, Penfield, New York.

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'Duane C. Basch', written over a horizontal line.

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